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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/560,556

02/21/2006

Yukiyoshi Watanabe

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EXAMINER

SHAMEEM, GOLAM M

ART UNIT

PAPER NUMBER

1626

MAIL DATE

DELIVERY MODE

01/29/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

10/560,556

Applicant(s)

WATANABE ET AL.

Examiner

Golam M. M. Shameem, Ph.D.

Art Unit

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 21 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 9-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 9-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>04/14/2006</u> | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Priority*

This application is a 371 of PCT/EP04/06125 06/07/2004, and the claim of foreign priority under 35 U.S.C. § 119(a)-(d) to Japan 2003-174758 06/19/2003 is acknowledged.

### *Status of Claims*

Claims 9-15 are currently pending in the application. Claims 1-8 were canceled.

### *Information Disclosure Statement*

Receipt is acknowledged of Information Disclosure Statement (IDS), filed on 04/14/2006, which has been entered in the file.

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. § 103(a), which forms the basis for all obviousness rejections, set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9-15 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Martinez *et al* (US 4,952,580) and further in view of Martinez *et al* (US 4,584,306). Applicant claims nematicidal thiazoline compounds, process for preparation and their method of uses thereof.

### *Determination of the scope and content of the prior art (MPEP §2141.01)*

Martinez *et al* ('580) teach analogous compounds, compositions and process of preparation to those of instantly claimed invention. Martinez *et al* ('306) also teach substituted thiazoline compounds to those of instantly claimed invention having similar utilities.

Ascertainment of the difference between the prior art and the claims (MPEP §2141.02)

The difference between the claimed compounds and that of the references herein lies in the selection of different substitutions in core thiazoline ring, such as having a methyl or ethyl group substitution for R variable of the instantly claimed compound instead of hydrogen for the same position in the prior art (column 21, Table 1, compound 1).

Finding of prima facie obviousness--rational and motivation (MPEP §2142-2413)

It would have been prima facie obvious to one having ordinary skill in the art at the time of the invention was made since Martinez *et al* teach compounds and compositions which are generic to the claimed compounds. It is well established that the substitution of alkyl (such as, methyl) for hydrogen on a known compound is not a patentable modification absent unexpected or unobvious results. *In re Wood*, 199 U.S.P.Q. 137 (C.C.P.A. 1978) and *In re Lohr*, 137 U.S.P.Q. 548, 549 (C.C.P.A. 1963). The disclosure of Martinez *et al* that teach several combinations, which would easily place Applicants invention in possession of the public at the time of Applicants invention, was filed. Therefore, in the instant case, one skilled in the art would be motivated to choose to replace a hydrogen atom with a methyl group or *vice versa* in view of the known teaching of the art. The claimed compounds are so closely related structurally to the homologous compounds of the reference as to be structurally obvious therefore in the absence of any unobviousness or unexpected properties. Since the core thiazoline ring of compound is not novel and the novelty (if there is any) belongs to the selection of different variable substitutions, a great caution should be exercised to determine the patentability of the claimed invention. Therefore, in looking at the instant claimed compounds as a whole, the

claimed compounds, composition and method of uses would have been suggested to one skilled in the art unless unobvious or unexpected results can be shown.

*Telephone Inquiry*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Golam Shameem, Ph.D. whose telephone number is (571) 272-0706. The examiner can normally be reached on Monday-Thursday from 6:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane, can be reached at (571) 272-0699. The Unofficial fax phone number for this Group is (703) 308-7921. The Official fax phone number for this Group is (571) 273-8300.

When filing a FAX in Technology Center 1600, please indicate in the Header (upper right) "Official" for papers that are to be entered into the file, and "Unofficial" for draft documents and other communications with the PTO that are not for entry into the file of the application. This will expedite processing of your papers.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [joseph.mckane@uspto.gov]. All Internet e-mail communications will be made of record in the application file. PTO employees will not communicate with applicant via Internet e-mail where sensitive data will be exchanged or where there exists a possibility that sensitive data could be identified unless there is of record an express waiver of the confidentiality requirements under 35 U.S.C. 122 by the applicant. See the Interim Internet Usage Policy published by the Patent and Trademark Office Official Gazette on February 25, 1997 at 1195 OG 89.

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Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist, whose telephone number is (571) 272-1600.

Golam M M Shameem, Ph.D.  
Primary Patent Examiner  
Art Unit 1626, Group 1600  
Technology Center 1

A handwritten signature in black ink, appearing to read 'M. M. Shameem', with a large, stylized initial 'M'.

**GOLAM M. M. SHAMEEM, PH.D**  
**PRIMARY EXAMINER**